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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,745	07/15/2003	Haruo Inoue	8012-1196	6925

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EXAMINER

FERNSTROM, KURT

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/618,745

Applicant(s)

INOUE, HARUO

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "light penetrating" renders the claims indefinite because the areas themselves do not penetrate light. Rather, light penetrates the areas. The term should be changed to "light-transmissive" or some similar terminology to make clear the subject matter being claimed.

Also, the term "orthogonally" in claim 1 is indefinite, as it is not clear what is being claimed. "Orthogonal" is defined as "intersecting at right angles", and it is not clear how the sub display unit and the main display units are related in this manner. It is understood that the axes of rotation of the sub display unit and the main display units are orthogonal to each other, but claim 1 does not recite axes of intersection. Further clarification is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (U.S. 5,395,111). Inoue discloses in Figure 2 and in the specification a symbol display device for a game machine comprising plural main display units (on outer ring 5a), each unit having a symbol and a light transmissive area (the non-symbol portion of ring 5a is transparent), a sub display unit 5b having symbols thereon which can be viewed through the light transmissive portion of ring 5a, and a winning judging section 44, described in column 4, lines 3-12 of the specification. With respect to claims 2, 3, 15 and 16, the light transmissive area of each display unit is a transparent part in the non-symbol area, which is either inside or outside the display part, depending on how "display part" is defined. With respect to claims 4, 5, 17 and 18, the claims recite functional language describing the intended function of the device. Under MPEP 2114, such language is generally accorded little if any patentable weight. The '111 patent reads on the structural limitations of the claims. With respect to claims 6 and 19, Inoue discloses that a composite symbol is formed as claimed. With respect to claims 7 and 20, ring 5b is a mechanical reel.

Claims 9-13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Malavazos. Malavazos discloses in Figures 1-3 and in the specification a symbol display device for a game machine comprising a plurality of display plates 13 and 14, each unit having a symbol and a light transmissive area (the non-symbol portions of plates 13 and 14 are transparent), a sub display unit 15 having symbols thereon which can be viewed through the light transmissive portions of plates 13 and 14, and a

winning judging section which judges whether a player wins based upon the combination of symbols. Malavazos discloses in column 2, lines 38-44 that the plates have ring shapes of different diameters, and are transparent. With respect to claim 10, the light transmissive area of each display unit is a transparent part in the non-symbol area, which is either inside or outside the display part, depending on how "display part" is defined. With respect to claims 11 and 12, the claims recite functional language describing the intended function of the device. Under MPEP 2114, such language is generally accorded little if any patentable weight. Malavazos reads on the structural limitations of the claims. With respect to claim 13, Malavazos discloses that a composite symbol comprising a plurality of images is formed. "Composite" is a broad term which is encompassed by Malavazos. With respect to claim 24, the transparent areas of Malavazos are alignable, as shown in Figure 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (U.S. 5,395,111) in view of Inoue (U.S. 5,752,881). Inoue ('111) discloses all of the limitations of the claims with the exception of the sub display unit being a liquid crystal display unit. However, such displays are known in the art, as disclosed for example in

column 9, lines 36-43 of Inoue ('881). It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Inoue ('111) by providing a liquid crystal display for the purpose of allowing a larger number of symbols to be displayed by the sub display.

### ***Allowable Subject Matter***

Claims 14-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: There is no suggestion in the prior art of a sub display unit which has an axis of rotation perpendicular to that of the plural display plates, nor is there any suggestion to modify the teachings of Inoue or Malavazos or the other prior art to arrive at such a feature.

### ***Response to Arguments***

Applicant's arguments filed on August 18, 2004 have been fully considered but they are not persuasive. With respect to claims 1-8, as noted above, the term "orthogonal" is indefinite, and does not overcome the previous rejections. With respect to claims 9-13, Malavazos reads on the claim language. The phrase "display part" is

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very broad, and is not defined in the claims in such a way as to overcome the prior art. Viewing Figure 1 of Malvazos, each display unit comprises a ring. The ring is divided into segments, where each segment comprises an indicia and the surrounding transparent material. Each of these segments is a "display part", comprising a symbol and a transparent area, thus reading on the claim language. This feature allows for completely independent rotation of the sub display unit, and is not a mere aesthetic choice of design.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
November 19, 2004

  
**KURT FERNSTROM**  
**PRIMARY EXAMINER**